

BEST AVAILABLE COPY

Remarks

Claims 1-44 were rejected under 35 U.S.C. 112, second paragraph as being **indefinite** for failing to particularly point out and distinctly claim the subject matter of the invention. In support of this rejection, the Office Action poses a series of questions regarding the claimed subject matter. The questions are copied below with responses and explanations:

It is not clear, how does the location of the vessels at different facilities limit their structure? The location of the vessels limits the structure of the claimed *population* of vessels, but not necessarily the vessels themselves. The population is positively recited in the claims, and members of the population are stated to be at various, clearly specified, locations. Thus, the location of the members of the population is a positive limitation on the claimed *populations* of vessels. An analogy would be to claim a road extending from Alexandria, Virginia to Richmond, Virginia. Those geographic locations structurally define the road.

Do the vessels at the distribution station structurally differ from the vessels at the testing laboratory? The structure of the vessels is defined by all of the limitations of the claim language. Thus, a phrase such as "each having a wireless electronic memory tag attached to the vessel" in the claim language is a limitation on the structure of vessels so described. Language describing the location of the vessels limits the structure of the claimed *populations* of vessels. The vessels at each location are not differentiated structurally from the vessels at the other locations, just like the portion of the road in Alexandria can be just like the portion in Richmond, differing in their locations.

If their structure is the same, then it is not clear, what is the patentable value of this limitation? The patentable value of any claim limitation is the same. If each of the limitations of a claim are not taught or suggested by the prior art, then the claimed invention is patentable over the prior art. This tenet of patent law applies equally to the applicant's claimed invention. Specifically, where a prior art reference does not disclose a population of vessels, located at the various specified locations, the reference does not anticipate the

71668.doc

11

claimed invention having a population so described. To continue the analogy, a road wholly within Alexandria does not anticipate a road extending from Alexandria to Richmond.

Moreover, it is not clear, if the same vessels should always be present at these particular locations, or these vessels are moving from one place to another? The language of a claim defines the invention. The claimed invention is not limited to vessels either remaining at or being transported from one facility to another. The claimed vessels are located at one specifically defined location, and transportable to another. Thus, the scope of the claims is clearly defined by the claim language such that the public will have no problem determining what constitutes infringement of the claims. See MPEP § 2173

If the vessels are moving and changing their location, how can such a system be definite?

The language of the claims describes a specific location at which members of a population of vessels are located. The vessels are transportable to another location. Thus, a person of ordinary skill in the art would have no trouble determining the scope of the claims. Where member of a population of vessels are located at the specified location, the claim conditions are met with respect to that element of the claim. See MPEP § 2173.02. Thus, the rejection of Claims 1-44 for indefiniteness is improper and should be withdrawn.

Claims 1-4, 6-7, 9-12, 14-15, 18-19, 21, 36-41, and 44 were rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,535,129 B1 to Petrick. However, a claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference. MPEP § 2131 citing *Verdegaal Bros. v. Union Oil Co. of California* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). But the Petrick reference nowhere discloses a diagnostic specimen system comprising a population of specimen vessels including members located at a vessel distribution facility, a specimen collection facility, and a specimen testing laboratory. This is evidenced by the fact that, in support of the rejection, the Office Action includes an entire page of single-spaced text explaining the Petrick reference, without once referring to either a vessel distribution facility, a specimen collection facility, or a specimen testing laboratory. Each and every element of

the claimed invention cannot be found in the reference. Thus, the reference clearly does not anticipate the claims.

Furthermore, the Office Action states that the declarations previously submitted as evidence that the Petrick reference is not prior art to the application are not appropriate because the application claims the same patentable invention as the Petrick reference. According to MPEP § 715.05, the application discloses the "same patentable invention" if its claims are either identical to or obvious in view of the claims of the Petrick reference. The Petrick reference claims business forms, not the population of biomedical specimen collection vessels located at and transportable between a vessel distribution facility, a specimen collection facility, and a specimen testing laboratory facility claimed by Applicant. Thus the same patentable invention is not being claimed, and Applicant is entitled to use 37 CFR § 1.131.

With respect to obviousness, the Office Action has asserted that only claims 5, 8, and 13 are obvious in view of Petrick, but these rejections are likewise improper because the Petrick reference does not teach or suggest all of the claim limitations. See MPEP § 706.02(j). Therefore, the claimed invention is not identical to or obvious in view of the Petrick reference, assuming that the reference is prior art to the application. So the application does not claim the same patentable invention as the Petrick reference, and declarations previously submitted as evidence that the Petrick reference is not prior art to the application are appropriate.


In addition, Claims 1, 6-7, 9-10, 14-15, 18-19, 21, 40-41, and 44 were rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,777,303 to Berney. The Berney reference does not teach or suggest a diagnostic specimen system comprising a population of specimen vessels including members located at a vessel distribution facility, a specimen collection facility, and a specimen testing laboratory, and an electronic memory tag attached to each vessel such that the tag remains attached to the vessel as the vessel is transported between facilities. Berney explicitly discloses at Col 1, Line 34 and again at Column 1, Line 63 that electronic memory labels are fixed on test tubes in a testing laboratory at the time of sample analysis. The Office Action asserted that the elements are an intrinsic feature of the invention. Counsel has conducted an electronic search of the entire MPEP and cannot find

one instance of the word "intrinsic" describing a reference upon which an anticipation rejection is based. Apparently, the Office Action means to assert that the claimed elements are "inherently" disclosed by the reference. However, to establish inherency, the reference must make clear that the allegedly inherent characteristic is *necessarily* present in the disclosure. MPEP § 2112 (IV.). With regard to the Berney reference, the allegedly inherent characteristic, i.e. the claimed location of the vessels, is in no way, shape, or form present in the disclosure, much less, *necessarily* present. The reference discloses that the electronic memory tag is affixed only during analysis of a specimen in a lab. The claimed structure of the wireless electronic memory tag of the invention is not present and especially not *necessarily* present, as required for inherency, in the reference. Thus, the anticipation rejections over the Berney reference are improper and should be withdrawn.

Claims 1, 6-7, 9-10, 14-15, 18-19, and 21 were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,777,303 to Berney in view of U.S. Patent No. 5,135,313 to Bowman. However, the Petrick reference does not teach or suggest all of the claim limitations of the claims. Specifically, the reference does not disclose the respective locations and transportability of the vessels. Thus, the obvious rejection is improper and should be withdrawn. See MPEP § 706.02(j).

Each of the independent claims of the application were rejected as unpatentable over either the Petrick or Berney reference, or one of the references in combination with one or more other references. Neither the Petrick, nor Berney, nor any of the other cited references teach or suggests all of the limitations of the claimed inventions of the independent claims of the application. Thus the rejections are improper, and the independent claims and their dependents are in condition for allowance.

Respectfully submitted,


Howard A. MacCord, Jr.
Registration No. 28,639
MacCord Mason PLLC
P. O. Box 2974
Greensboro, NC 27402
(336) 273-4422

71658.doc

14

Date: February 16, 2005
File No.: 2552-011

CERTIFICATE OF TRANSMISSION

I HEREBY CERTIFY THAT THIS DOCUMENT IS
BEING FACSIMILE TRANSMITTED TO THE
PATENT AND TRADEMARK OFFICE (FAX NO.
(703) 872-9306) TO: EXAMINER Yelena G. Gukh,
ART UNIT 1743

ON February 16, 2005

(Date of Deposit)

Christian E. Carter-Seyboth

Name of Depositor

Christian E. Carter-Seyboth
Signature

71668.doc

15

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.